

REMARKS

Claims 1-29 remain pending in this application. Claims 1-10, 14, and 15 were amended herein. Support for the amendments can be found at least at page 5, lines 23-24. Favorable reconsideration is respectfully requested in light of the amendments and remarks submitted herein.

Claims 1-10 and 14-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miyano et al. JP10109906 or Bessette et al. WO 0118201. Applicant respectfully traverses this rejection.

Claims 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyano et al. JP10109906 alone or further in view of Bessette et al. WO 0118201. Applicant respectfully traverses this rejection.

Rejection under 35 U.S.C. § 102(b)

Claims 1-10 and 14-25 are rejected under 35 U.S.C. § 102(b) as being anticipated by Miyano et al. JP10109906 or Bessette et al. WO 0118201. Applicant has amended the independent claims 1 and 10 to recite that the composition contains both carvacrol and thymol. Applicant respectfully asserts that neither Miyano nor Bessette anticipates the amended claims.

Both Miyano and Bessette teach compositions that can contain a vast number of compounds, two of which include carvacrol and thymol. However, because Miyano and Bessette only teach a genus of compositions and do not identically disclose or describe, within the meaning of 35 U.S.C. § 102, the claimed species, they do not anticipate the pending claims. Furthermore, because the genus would include an untold number of species it does not disclose the claimed species. In determining whether a genus anticipates a species, a number of factors have to be considered, including the number of species disclosed, and whether or not there is any particular teaching about the particular components of the species that Applicant claims.

Miyano describes compositions that can include active principles and mildew proofing constituents. The active principles can be chosen from: paraoxybenzoic acids, dehydroacetic acid or its salts, sorbic acids or its salts, 2-(4-thiazolyl) benzimidazole, imazalil, orthophenyl phenol or its salts, diphenyl, glycerine fatty acid esters, polylysine, chitosan, Artemisia capillaris extract, Timor, and carvacrol. The mildew proofing constituents can be chosen from: metal hydroxides, organic acids such as benzoic acid, fumaric acid, itaconic acid, adipic acid,

propionic acid or salts thereof, zinc oxide, metaboric acid, barium, zinc, and calcium. The number of possible combinations that could be created using these two lists is extremely large. Miyano offers no specific mention of thymol, carvacrol, or zinc, beyond their mention in the lists of possible components.

Therefore, because Miyano includes a very large number of species and does not offer any particular suggestion or indication about the particular species that Applicant is claiming, Applicant respectfully asserts that the genus disclosed in Miyano does not anticipate the particularly claimed species of Applicant's pending claims. Stated another way, Applicant respectfully asserts that one of ordinary skill in the art would not have been able to "at once envisage" the specific composition with the generic disclosure of the numerous compositions, and therefore the specific compositions claimed are not anticipated.

Similarly, Bessette also includes a number of species with no indication regarding the claimed species. Bessette discloses compositions that include naturally occurring plant substances. The naturally occurring plant substances exemplified in the disclosure of Bessette include phenethyl propionate, methyl salicylate, pulegone, carvacrol, thymol, thyme oil, citronellal, eugenol, α -terpineol, cinnamic alcohol, benzyl alcohol, phenethyl alcohol, t-anethole, d-limonene, eucalyptol, citronellal 80, thyme red, thyme white, vanillin, α -phellandrene, piperonyl alcohol, piperonyl acetate, piperonal, R-limonene, ethyl vanillin, p-cymene, iso-eugenol, guaiacol, and benzyl acetate.

The only combinations disclosed in Bessette are thymol, t-anethole, α -terpineol, eugenol, and citronella; eugenol, α -terpineol and cinnamic alcohol; benzyl alcohol, phenethyl propionate, phenethyl alcohol, and α -terpineol; pulegone, eugenol, and α -terpineol; α -terpineol and eugenol; α -terpineol and phenethyl alcohol; eugenol and phenethyl alcohol; benzyl alcohol, phenethyl alcohol, phenethyl propionate and α -terpineol; phenethyl alcohol, α -terpineol, and benzyl alcohol; phenethyl alcohol, α -terpineol, benzyl alcohol, and phenethyl propionate; phenethyl alcohol, α -terpineol, benzyl alcohol, phenethyl propionate, and eugenol; phenethyl alcohol, and pyrethrins; α -terpineol, and pyrethrins; benzyl alcohol and pyrethrins; phenethyl propionate and pyrethrins; eugenol and pyrethrins; thymol, t-anethole, α -terpineol, eugenol, citronella, and phenethyl propionate; thymol and phenethyl propionate; thymol, t-anethole, α -terpineol, eugenol, citronella, and benzyl alcohol; and thymol, t-anethole, α -terpineol, eugenol, citronella, and

eugenol. Applicant also notes that the 20 different compositions that are specifically disclosed in Bessette are a small fraction of those that are possible.

Neither the general disclosure nor the specific combinations disclosed in Bessette would immediately point one of skill in the art to the specific combination claimed by the Applicant. Although a number of the combinations disclosed include thymol, none of the combinations include carvacrol.

With respect to the recitation of "at least one salt comprising a transition metal", Applicant notes that the only mention of transition metals is at line 13, page 21 of the PCT publication of Bessette. This passage mentions that certain other compounds may be included, such as colorants and trace elements. Zinc is given as one of the seven exemplary trace elements that could be included. No indication is given for the reason for including the trace elements, and none of the examples includes any trace elements, let alone zinc. The addition of the various carriers, and additives discussed greatly expands the number of possibilities provided in Bessette.

Therefore, because Bessette includes a very large number of species and does not offer any particular suggestion or indication about the particular species that Applicant is claiming, Applicant respectfully asserts that the genus disclosed in Bessette does not anticipate the particularly claimed species of Applicant's pending claims. Stated another way, Applicant respectfully asserts that one of ordinary skill in the art would not have been able to "at once envisage" the specific composition with the generic disclosure of the numerous compositions, and therefore the specific compositions claimed are not anticipated.

Based on the amendments made to the claims, and the comments offered above, Applicant respectfully asserts that the currently pending claims are not anticipated by either Miyano or Bessette. Applicant therefore respectfully requests that this rejection be withdrawn.

Although not specifically raised by the Examiner, Applicant respectfully asserts that neither Miyano, Bessette, nor the combination thereof render the pending claims obvious. Applicant reiterates the comments offered above, and asserts that because of the large number of species within the genres of Miyano and Bessette, and the lack of teaching towards Applicant's combination, there would not have been any motivation to utilize the specific combination claimed by the Applicant.

Rejection under 35 U.S.C. § 103(a)

Claims 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Miyano et al. JP10109906 alone or further in view of Bessette et al. WO 0118201. Although the rejection has not been raised with respect to the newly amended claims, it will be addressed to the extent that it may be relevant.

Applicant reiterates the comments offered above with respect to the vastness of the genus disclosed by both Miyano and Bessette, as well as the lack of disclosure indicating the particular combination.

Based on the amendments to the claims and the remarks offered above, Applicant respectfully requests that this rejection be withdrawn.

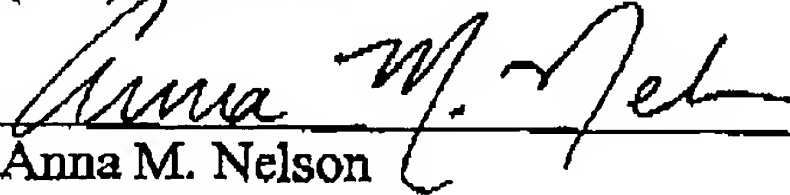
Conclusion

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: September 10, 2003



Anna M. Nelson
Reg. No. 48,935
AMN/vh

MEMORY TRANSMISSION REPORT

PAGE : 001
TIME : SEP-10-03 03:19PM
TEL NUMBER1: 6123329081
TEL NUMBER2: 6123329081
NAME : Merchant & Gould 1

FILE NUMBER : 661
DATE : SEP-10 03:16PM
TO : 2555181917038729306
DOCUMENT PAGES : 010
START TIME : SEP-10 03:16PM
END TIME : SEP-10 03:19PM
SENT PAGES : 010
STATUS : OK

FILE NUMBER : 661

*** SUCCESSFUL TX NOTICE ***

Merchant & Gould
An Intellectual Property Law Firm

3200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota
55402-2215 USA
tel 612.332.5300
fax 612.332.9081
www.merchant-
gould.com

A Professional Corporation

Fax Transmission | September 10, 2003

TO: Commissioner for Patents
Attn: Examiner H. Lilling
Patent Examining Corps
Facsimile Center
Washington, D.C. 20231

FROM: Anna M. Nelson

OUR REF: 12996.4USU1
TELEPHONE: 612.332.4701

Total pages, including cover letter: 10

PTO FAX NUMBER 1-703.872.9306

If you do NOT receive all of the pages, please telephone us at 612.371.5394, or fax us at 612.332.9081.

Title of Document Transmitted: Amendment
Applicant: Ninkov
Serial No.: 10/056593
Filed: January 23, 2002
Group Art Unit: 1651
Our Ref. No.: 12996.4USU1

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.

By: Anna M. Nelson
Name: Anna M. Nelson
Reg. No.: 48,935

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.

Victoria Johnson
Signature

September 10, 2003
Date

Auto-Reply Facsimile Transmission



UNITED STATES
PATENT AND
TRADEMARK OFFICE

TO:

Fax Sender at 6123329081

Fax Information

Date Received:

Total Pages:

9/10/03 4:27:36 PM [Eastern Daylight Time]

10 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page

=====>

SEP-10-03	08:16PM	FROM: Merchant & Gould	6123329081	7-485	P.001/010	F-001
Merchant & Gould An Intellectual Property Law Firm				<div>3200 IDS Center 60 South Fifth Street Minneapolis, Minnesota 55402-2212 USA tel 612.332.3300 fax 612.332.9081 www.merchant gold.com</div> A Professional Corporation		
Fax Transmission September 10, 2003						
TO: Commissioner for Patents Attn: Examiner H. Lilling Patent Examining Corps Facsimile Center Washington, D.C. 20231				FROM: Anna M. Nelson		
				OUR REF: 12996.4USU1 TELEPHONE: 612.336.4701		
Total pages, including cover letter: 10						
PTO FAX NUMBER 1-703.872.9306						
If you do NOT receive all of the pages, please telephone us at 612.371.3394, or fax us at 612.332.9081.						
Title of Document Transmitted: <u>Amendment</u>						
Applicant: <u>Ninjaboy</u>						
Serial No.: <u>10/056592</u>						
Filed: <u>January 23, 2002</u>						
Group Art Unit: <u>1651</u>						
Our Ref. No.: <u>12996.4USU1</u>						
Please charge any additional fees or credit overpayments to Deposit Account No. 13-2725. Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.						
By: <u>[Signature]</u> Name: <u>Anna M. Nelson</u> Reg. No.: <u>48,035</u>						
I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below						
<u>[Signature]</u> Signature				<u>September 10, 2003</u> Date		
CD-03.007						
Received from 6123329081 > at 9/10/03 4:27:36 PM [Eastern Daylight Time]						